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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,792	12/31/2001	Daniel Steven Kline	85447.000052	2970 5
23387	7590	10/03/2003	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			OSELE, MARK A	
		ART UNIT	PAPER NUMBER	
			1734	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)
	10/038,792	KLINE ET AL.
	Examiner Mark A Osele	Art Unit 1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-6,13-16 and 20-25 is/are rejected.  
 7) Claim(s) 7-12,17-19 and 26-31 is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 22 April 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.<br> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.<br> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5 and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Publication 2000-313097 (Okada et al.). It is noted that U.S. Patent 6,500,291 is an English language equivalent to Okada et al. Okada et al. shows a transfer application and peel apparatus for peeling a donor, m, from a laminated printed media comprising: a support path, 15, for conveying a plurality of attached laminated printed articles along a first path; and a peel guide, 12, for guiding the donor to a donor take-up reel, 14, the peel guide positioned so that the angle between the

donor and the laminated article remains substantially constant as the donor take-up reel fills with donor and changes the angle at which the donor leaves the peel guide (See Fig. 5). It is noted that the layer transferred to the substrates is a printed layer not an overcoat layer, but the limitations of the materials worked upon are not given patentable weight in an apparatus claim.

Regarding claims 2 and 21, Okada et al. further shows a second peel guide (not numbered but shown in Fig. 5) on a second side of the donor between the donor and the laminated printed article such that the second peel guide guides the laminated printed article.

Regarding claims 3 and 22, Okada et al. further shows a donor guide, 13, downstream of the peel guide such that the donor guide resists tension from the donor take-up reel so that the angle between the donor and the laminated media remains substantially constant.

Regarding claims 4 and 23, Okada et al. further shows a second peel guide (one of conveying rollers 15) forming a nip with the first peel guide.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Paulson et al. Paulson et al. shows an overcoat application peel apparatus for peeling a donor, 17, from a laminated printed media comprising: a support path, 22, for conveying a plurality of attached laminated printed articles along a first paper path; and a peel guide, 48, for guiding the donor to a donor take-up reel, 20, the peel guide positioned so that the angle between the donor and the laminated article remains

substantially constant as the donor take-up reel fills with donor and changes the angle at which the donor leaves the peel guide (See Figs. 1 and 2). It is noted that the layer transferred to the cards is a printed layer not an overcoat layer, but the limitations of the materials worked upon are not given patentable weight in an apparatus claim.

Regarding claim 3, Paulson et al. further shows a donor guide, 54, downstream of the peel guide such that the donor guide resists tension from the donor take-up reel so that the angle between the donor and the laminated media remains substantially constant.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 6, 13-16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Publication 2000-313097 (Okada et al.) in view of

Ohta et al. As shown in paragraph 2 above, Okada et al. shows the claimed subject matter except for the exit platen disposed at an angle to the paper path. Ohta et al. shows a lamination device wherein the exit platen, 34, is angled with respect to the paper path. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an angled platen in the apparatus of Okada et al. because Ohta et al. shows that this type of platen allows for gravity to bring the peeled, laminated articles out of the apparatus.

7. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paulson et al. Paulson et al. shows an overcoat application peel apparatus for peeling a donor, 17, from a laminated printed media comprising: a donor supply reel, 18, a heated fuser guide, 24, a pressure guide and support path, 22, for producing a mechanical nip with the fuser guide and conveying a plurality of attached laminated printed articles along a first paper path; a donor guide, J-shaped guide in Fig. 2, that guides the laminate carrying donor into the nip; and a peel guide, 48, for guiding the donor to a donor take-up reel, 20, the peel guide positioned so that the angle between the donor and the laminated article remains substantially constant as the donor take-up reel fills with donor and changes the angle at which the donor leaves the peel guide (See Figs. 1 and 2). It is noted that the layer transferred to the cards is a printed layer not an overcoat layer, but the limitations of the materials worked upon are not given patentable weight in an apparatus claim. Paulson et al. fails to show an entry roller for accepting the cards from a source. It would have been obvious to one of ordinary skill

in the art at the time the invention was made to add an entry roller to the apparatus of Paulson et al. as rollers are conventional for supplying cards to a laminating nip.

Regarding claim 22, Paulson et al. further shows a donor guide, 54, downstream of the peel guide such that the donor guide resists tension from the donor take-up reel so that the angle between the donor and the laminated media remains substantially constant.

***Allowable Subject Matter***

8. Claims 7-12, 17-19, and 26-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art shows a peel guide located to bend the laminated printed article around the peel guide.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kobayashi et al., Hagstrom, and Nagata et al. each show transferring and peeling devices.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 703-308-2063. The examiner can normally be reached on Mon-Fri 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



MARK A. OSELE  
PRIMARY EXAMINER

September 22, 2003